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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,477	04/08/2004	Yuka Hasegawa	P/1909-168	1055

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/821,477	Applicant(s) HASEGAWA, YUKA	
	Examiner Melur Ramakrishnaiah	Art Unit 2614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (see the enclosed explanation).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


 Melur Ramakrishnaiah
 Primary Examiner
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Response to Arguments to Final Rejection

Claims 1-24 are pending.

Claims 1-2, 13 and 14 are rejected under 35 U.S.C. j103 as being unpatentable over U.S. Patent No. 6,515,695 to Sato et al. (Sato) in view of JP 07-115633 to Nishimura

Claims 8-9 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishimura.

Claims 3-7 and 15-19 are rejected under 35 U.S.C. j 103(a) as being unpatentable over Sato in view of Nishimura and further in view of JP 1 1-234641 to Saiki

Claims 10-1 1 and 22-23 are rejected under 35 U.S.C. j 103 as being unpatentable over Nishimura in view of Saiki.

Claims 12 and 24 are rejected under 35 U.S.C. j 103 as being unpatentable over Nishimura in view of JP 2003032727A to Nakajima.

Regarding rejection of independent claims 1, 8, 13 and 20, Applicant states that "All of the independent claims 1, 8, 13 and 20 claim a reply method in a video telephone terminal related to a telephone number of a communication terminal, where reply method includes a reply using any of a camera image, a still image or substitute image. The Office Action agrees that such limitations are not shown in the Sato reference and points to Nishimura. However, even a combination of Sato and Nishimura does not does not show a reply method related telephone number where the reply method includes one of the above images. In Sato connection procedure established based on telephone call ... In Nishimura, images may be sent to a communicating terminal, however, there is no indication that such images are based on telephone number of the

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telephone number of the communicating terminal as claimed. As such, even a combination of Nishimura and Sato references will not yield the above reference limitations because even a combination of the two references does not yield a reply method related to a telephone number and including images as is claimed". Contrary to applicant's interpretation of Nishimura reference, Nishimura discloses a video telephone system in which reply method including a reply using any one of camera image, or still image (note image are stored in memory related to telephone number of the communicating terminal). This is effected when video telephone terminal receives a telephone call and based on the telephone number of communicating terminal reply method is effected which includes both audio and stored video image (see abstract, and paragraphs: 0006, 0010-0016). Since Nishimura clearly teaches applicant's claim limitations such as reply method related to a telephone number and including images, rejection of independent claims 1, 8, 13, 20 is maintained as set forth in the final rejection.

Applicant further alleges that "there is no motivation shown in the cited art for combining Sato and Nishimura as is required under MPEP 706.02(j). The examiner states on page 3 of the Office Action ... Yet, there is no indication wherein prior art there is motivation for actually making such a modifications of either Sato or Nishimura. The examiner appears to be simply stating a perceived benefit of the combination and not a motivation for actually making the combination. As such, a prima facie case of obviousness cannot be made". Regarding this, Office action clearly states the motivation to combine Sato and Nishimura. For example Office Action states the

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reply method including using any one of a camera image, a still image, or a substitute image.

However, Nishimura discloses video telephone system which teaches the following: the reply method including a still image (abstract; paragraphs: 0006, 0010-0016).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Sato's system to provide for the following: the reply method including using any one of a camera image, a still image, or a substitute image as this arrangement would facilitate audio and video message appropriate for the caller as taught by Nishimura, thus facilitating sending appropriate message to the caller suitable for him.

This clearly shows that Nishimura provides motivation to combine Sato with Nishimura which states the following: to provide an excellent workability and convenience by storing plural response messages in a voice message storage part and video message storage part and registering which response message is transmitted to which party on a message selection condition registration part (see abstract of Nishimura). Therefore, Nishimura clearly provides motivation to combine Sato with Nishimura as it provides an advantage of providing individual and customized reply method which includes stored voice and images which are sent based on the telephone number of the communicating terminal. As such, a prima facie case of obviousness can be made and rejection of the claims is maintained.

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Applicants arguments with respect to dependent claims are tied to independent claims being patentable which are not as explained above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614